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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,988	12/27/2000	Morinobu Endoh	107348-00047	3626

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EXAMINER	
LISH, PETER J	

ART UNIT	PAPER NUMBER
1754	

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/747,988	ENDOH ET AL.	
	Examiner	Art Unit	
	Peter J Lish	1754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *8-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejection of the previous office action is maintained in its entirety and incorporated herein by reference.

Claims 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "an electrostatic capacity containing the activated carbon material" is unclear and indefinite. Perhaps "an electrostatic capacitor containing the activated carbon material" is meant.

Claim Rejections - 35 USC § 102/103

Claims 8-10 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Adachi et al. (USPN 5,430,606).

The rejection of the previous office action is maintained in its entirety and incorporated herein by reference.

Claims 8-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sato et al. (JP 10149958 A).

The rejection of the previous office action is maintained in its entirety and incorporated herein by reference.

Claims 8-10 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Maeda et al. (US 6,118,650).

The rejection of the previous office action is maintained in its entirety and incorporated herein by reference.

Response to Arguments

Applicant's arguments filed 9/3/04 have been fully considered but they are not persuasive. Applicants argue with respect to the rejections under 35 U.S.C. 112, first paragraph, that the applicants have amended the claims to define that the electrostatic capacity is measured from an electrostatic capacitor containing the activated carbon, as suggested by the Examiner. However, even if this were the case, it is maintained that this value is not a property of the activated carbon, but rather relies upon factors stemming from the manufacture of the electrodes

and the capacitor. There is no discussion of the formation of the electrodes or the capacitor itself, thus there is a lack of written description dealing with the measurement of this claimed property.

Applicants argue, with respect to the rejections over Adachi, that Adachi does not teach the use of "graphitizable carbon" in the process of making the activated carbon product. However, it is seen that Adachi teaches that the activated carbon precursor may be any carbonaceous material generally used for the manufacture of activated carbon, including coconut shells, wood flour, coal, or resins. Adachi specifically uses phenolic resin, which is similarly used in the instantly claimed invention and taught to be a "graphitizable carbon". While the carbon precursor of Adachi et al. is not explicitly taught to be mesophase pitch, the use of a specific precursor in the formation of the activated carbon is viewed to be a product by process limitation. No difference is seen between the activated carbon of Adachi et al. and that of the instantly claimed invention. It is held that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. The burden to show a different product is thereby shifted to the applicant, as the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith. See *In re Brown*, 173 USPQ 685, 688 and *In re Fessman*, 180 USPQ 324.

Applicants argue, with respect to the rejections over Adachi, that Adachi does not teach the area rate of edge faces of the activated carbon product. Because the electrostatic capacity

density and the surface areas of the activated carbon of Adachi et al. fit within the claimed ranges of the applicant, and because these properties are used to calculate the rate of edge faces, it is expected that the activated carbon of Adachi et al. have a rate of edge faces within the claimed range of applicants.

Applicants argue, with respect to the rejections over Sato, that Sato teaches electrostatic capacitys of between 0-39 F/cc in embodiments 1-3, which do not meet the claimed range of the applicants. However, it is noted that the electrostatic capacity is measured from an electric double layer capacitor in which the activated carbon is formed into electrodes and the electrodes incorporated into the capacitor. The specification contains no description on the assembly of the electrodes or the capacitor. It is thus unclear as to what binder was used to form the electrodes, whether additives were used in the electrodes, what type of electrolyte was used in the capacitor, and what voltage was used in the measurement, all of which may have an effect on the electrostatic capacity. It is thus considered that while an electrostatic capacity density within the range claimed by the applicants is not explicitly taught, it is expected that the activated carbon of Sato, which is produced by an equivalent process, will achieve an equivalent electrostatic capacity density if applied in a manner identical to applicant. Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the burden of proof is shifted to the applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. See In re Best, 195 USPQ 430.

Applicants additionally argue that the process of Sato is not equivalent to the process of the claimed invention by arguing toward an infusibilization step used in examples III and IV.

However, it is noted that the applicant's example relied upon in the rejection of the previous office action is example V.

Applicants argue, with respect to the rejections over Maeda, that Maeda does not teach the area rate of edge faces of the activated carbon product. However, because no difference is seen between the process used to form the activated carbon of Maeda et al. and the process of the instantly claimed invention, it is expected that the activated carbon will have equivalent properties. Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the burden of proof is shifted to the applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. See In re Best, 195 USPQ 430.

Applicants additionally argue that Maeda does not teach the formation of an activated carbon powder, but rather produces milled activated carbon fibers. It is not seen how the milled fibers of Maeda differ from a powder, as they are milled to dimensions that surely classify them as a powder. No aspect ratio, which may differentiate a powder of spherical particles from the powder of milled fibers of Maeda is claimed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Lish whose telephone number is 571-272-1354. The examiner can normally be reached on 9:00-6:00 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PL

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SUPERVISORY PATENT EXAMINER
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